

REMARKS

The Official Action mailed November 22, 2010, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on June 30, 2006 and September 3, 2010.

Claims 14-39 were pending in the present application prior to the above amendment. Claims 14, 15, 26 and 27 have been amended to better recite the features of the present invention. The Applicant notes with appreciation the indication of the allowability of claims 24 and 36. Accordingly, claims 14-39 are now pending in the present application, of which claims 14, 15, 26 and 27 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 14-17, 25-29 and 37-39 as anticipated by U.S. Publication No. 2003/0216012 to Sasaki. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claims 14, 15, 26, and 27 are amended to better recite the features of the invention. In particular, independent claims 14 and 26 have a feature "blocking end portions of a first laser beam emitted from a laser oscillator by a slit to produce a second laser beam." Independent claims 15 and 27 have been similarly amended and after combining first and second laser beams into a third laser beam recite "blocking

end portions of the third laser beam by a slit to produce a fourth laser beam." These features are supported, for example, by Applicant's FIGS. 1 and 4 and paragraphs [0036] to [0039] of the original specification. These features allow, for example, blocking of a portion of the laser beam, such as a low-intensity part as shown in FIG. 2B.

The Official Action on page 6 again contends that Sasaki teaches a slit 76. The Applicant respectfully disagrees. Element 76 in Sasaki is specifically described and illustrated as a "substantially semicircular cylindrical lens." Alleged element 76 in Sasaki does not function as a slit, but is instead taught in alleged paragraph [0133] to be merely a lens through which the laser passes. Applicant notes that the Response to Arguments section on page 6 of the Official Action does not address Applicant's previous arguments regarding this issue, but instead merely reiterates the conclusory statement that Sasaki does produce laser beams "by passing through a slit 76." That is, the Patent Office has provided no substantiated rationale for defining of the disclosed cylindrical lens 76 in Sasaki as a "slit." Rather, for reasons discussed above, one of ordinary skill in the art would not have considered lens 76 in Sasaki to be a slit or to function as a slit. Thus, the unsubstantiated labeling of lens 76 in Sasaki as a "slit" does not make it so and a *prima facie* case of anticipation has not been met.

Moreover, Sasaki also fails to appreciate any benefit to providing a slit to block end portions of a laser. Therefore, Sasaki does not disclose expressly or inherently the recited feature of blocking end portions of a first (or third) laser beam emitted from a laser oscillator by a slit to produce a second (or fourth) laser beam as recited in the amended independent claims.

Since Sasaki does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 18-23 and 30-35 as obvious based on the combination of Sasaki, U.S. Publication No. 2003/0086182 to Tanaka and U.S. Publication No. 2006/0138102 to Sawada. The Applicant respectfully traverses the rejection because a *prima facie* case of obviousness cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With respect to independent claims 14, 15, 26 and 27, the prior art, either alone or in combination, does not teach or suggest all the features of the independent claims, as amended. In particular, as discussed above, Sasaki fails to teach blocking end portions...by a slit as recited in the independent claims. Tanaka and Suwada do not cure the deficiencies of Sasaki.

Because Sasaki, Tanaka and Suwada do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to

independent claims 14, 15, 26 and 27. Therefore, Applicant believes the rejections of claims 14, 15, 26 and 27 and claims dependent therefrom are not proper.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,


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